


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## In re Application of:

Applicant : Caruso Property Management, Inc.  
Serial No. : 78/241,396  
Filed : April 23, 2003  
Mark : Design Only  
Docket : 158989-0002/T04613US  
Law Office : 105  
Attorney : Barbara Rutland, Esq.

## CERTIFICATE OF MAILING

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ALEXANDRIA, VA 22313-1451.

  
Name: AURORA E. GOMEZ

## APPLICANT'S APPEAL BRIEF

Jane Shay Wald, Esq.  
IRELL & MANELLA LLP  
1800 Avenue of the Stars, Suite 900  
Los Angeles, California 90067  
(310) 277-1010

Design Only  
Serial No.: 78/241,396  
Page 1

## **I. INTRODUCTION**

Caruso Property Management, Inc. ("Applicant") appeals from the final decision of the United States Patent and Trademark Office Examining Attorney refusing registration of the above referenced mark. Applicant has amended the application to delete the services "providing business marketing information." The Amendment is submitted as Exhibit A hereto. Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision and allow the mark.

The Examining Attorney refused to allow registration on the basis that the substitute specimen filed March 8, 2004 ("substitute specimen") did not show use of the mark in connection with the specified services of International Class 35.<sup>1</sup> Applicant timely filed its Notice of Appeal of the Examiner's decision. Applicant contends that the specimens submitted in support of the services in Class 35 show the mark in respect of the particular services identified, especially in view of the Exhibit A Amendment.

## **II. THE SPECIMENS SUBMITTED SHOW THE MARK USED IN CONNECTION WITH THE CLASS 35 SERVICES IDENTIFIED**

By way of background, Applicant clarifies that, as can be observed from the specimen of record, The Grove is a large and extremely popular outdoor shopping

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<sup>1</sup> The Final Office Action required Applicant to file a declaration or affidavit, pursuant to 37 C.F.R. § 2.20, verifying that the substitute specimens were in use in commerce at least as early as the filing date of the application for both Classes 35 and 36. The requested Declaration Under 37 CFR § 2.20 for both Classes 35 and 36 was timely filed on September 28, 2004. Applicant understands that no issue remains with respect to the registrability of the mark with respect to Class 36, and that this Appeal pertains to the refusal with respect to Class 35.

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center/shopping environment in Los Angeles, resembling a beautiful village more than the prototypical shopping mall. There are fine dining restaurants, movie theatres, and upscale stores in a lushly landscaped environment, as well as grassy areas overlooking a large, sculptural water fountain, where shoppers, diners, moviegoers and other visitors can relax and watch live entertainment. There is a logo used in various ways in connection with the shopping center environment. Additionally, the logo is used in connection with advertising, promotional and business for others, namely, the tenants of the Applicant's shopping environment. That logo is the mark sought to be registered herein.

The Application is a multi-class application in Classes 35 and 36. With respect to the claimed "Retail Shopping Center Services," in Class 36, the Examining Attorney found the specimens to be proper, and merely requested a Declaration which, as noted in Footnote 1 and of record, was timely filed in response to the Final Office Action.

Hence, this Appeal concerns Class 35, and specifically the Applicant's specimens with respect to Class 35. Applicant urges that the substitute specimens filed by Applicant are sufficient to show use of the mark in connection with the enumerated services of Class 35.

Trademark Rule 2.56 regarding service mark specimens reads, in part, "A service mark specimen must show the mark as actually used in the sale or advertising of the services." 37 C.F.R. §2.56(b)(2). Most specimens supporting a service mark registration appear in the form of advertisements; West Fla. Seafood v. Jet Rests., 31 F.3d 1122, 1126 n.6 (Fed. Cir. 1994) ("Advertisements may constitute acceptable 'specimens' of use.").

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Serial No.: 78/241,396  
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The application on appeal lists the services in Class 35 as:

Dissemination of advertising material for others; preparing and placing advertisements for others; promoting the goods and services of others through promotional offers; promoting the sale of goods and services of others through the distribution of printed material; providing business marketing information.

Per Exhibit A, the Applicant has amended the application to delete "providing business marketing information." The identification of the remaining services specifies that each of the services listed above is done on behalf of others. These others, as is evident from the substitute specimen, are the tenants within the Applicant's shopping center. Applicant's substitute specimen for Class 35 shows the use of the mark in connection with each of these services.

The Class 35 substitute specimen brochure of record advertises (through an educational children's tool) establishments within Applicant's shopping center, namely, Pottery Barn Kids, Barnes and Noble, Nordstrom, and Gap Kids. The brochure supports the claimed services of "Dissemination of advertising material for others," because, for example, Pacific Theaters benefits from this advertisement offered in connection with the mark sought to be registered, as do Wishing Bear, Pottery Barn Kids, Barnes and Noble, Nordstrom, and Gap Kids.

The substitute specimen brochure for Class 35 includes coupons for a dollar off a movie tray at Pacific Theatres as well as twenty-five (25) percent off any animal outfit at Wishing Bear. Both Pacific Theatres and Wishing Bear are establishments located within Applicant's shopping center, as is apparent from the substitute specimen itself. Applicant advertises and promotes the goods and services of others through the distribution of this

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printed material, as noted in the recitation of services in the application on appeal.

Consequently, Applicant contends that the substitute specimen shows use of the mark in relation to the specified services under International Class 35.

### III. CONCLUSION

For the foregoing reasons, Applicant respectfully submits that the Examiner's final decision should be reversed and the above-referenced mark should be allowed to register.

Respectfully submitted,  
IRELL & MANELLA LLP

Dated: April 6, 2005

By: Jane Shay Wald  
Jane Shay Wald

1800 Avenue of the Stars, Suite 900  
Los Angeles, California 90067  
(310) 277-1010

10/21/2005 13:33 FAX 310 203 7199

IRELL & MANELLA

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## EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Name: AURORA E. GOMEZ

## AMENDMENT

Applicant amends the application by deleting from the identification of services in Class 35 of the application the following: "Providing business marketing information." Applicant believes the Application is in condition for allowance and respectfully requests the same.

Respectfully submitted,  
IRELL & MANELLA LLP

Dated: April 6, 2005

By: 

Jane Shay Wald

1800 Avenue of the Stars, Suite 900  
Los Angeles, California 90067  
(310) 277-1010

Atty: Jane Shay Wald, Esq. Date Mailed: April 6, 2005  
Client: Caruso Property Mgmt. Client/Matter #: 158989-0002

**COMMISSIONER FOR TRADEMARKS:**

In re Serial No.: 78/241,396 Filed: April 23, 2003  
Applicant: Caruso Property Management, Inc.  
Mark: DESIGN only  
Classes: 35 and 36  
Docket: 158989-0002/T04613US

Please acknowledge receipt of the following items by stamping  
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**Cohen, Missy**

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**Sent:** Friday, October 21, 2005 1:24 PM  
**To:** Cohen, Missy; Wald, Jane Shay  
**Subject:** ESTTA. Applicants Request for Remand and Amendment confirmation receipt ID: ESTTA49890

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Tracking No: ESTTA49890

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Proceeding: 78241396  
Applicant: Caruso Property Management, Inc.  
Correspondence Address: Jane Shay Wald, Esq.  
IRELL & MANELLA  
1800 AVENUE OF THE STARS SUITE 900  
LOS ANGELES, CA 90067-4276

Submission: Applicants Request for Remand and Amendment

Attachments: AppealT04613.pdf ( 4 pages )

Filer's Name: Jane Shay Wald  
Filer's e-mail: mcohen@irell.com, jwald@irell.com  
Signature: /Jane Shay Wald/  
Date: 10/21/2005



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<b>Applicant</b>	Caruso Property Management, Inc.
<b>Correspondence Address</b>	Jane Shay Wald, Esq. IRELL & MANELLA 1800 AVENUE OF THE STARS SUITE 900 LOS ANGELES, CA 90067-4276
<b>Submission</b>	Applicants Request for Remand and Amendment
<b>Attachments</b>	AppealT04613.pdf ( 4 pages )(219590 bytes )
<b>Filer's Name</b>	Jane Shay Wald
<b>Filer's e-mail</b>	mcohen@irell.com, jwald@irell.com
<b>Signature</b>	/Jane Shay Wald/
<b>Date</b>	10/21/2005

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REQUEST FOR REMAND  
TO EXAMINING ATTORNEY TO  
ENTER PROPOSED AMENDMENT

Applicant respectfully requests the application be remanded to the Examining Attorney to enter the proposed amendment to delete

"Providing business marketing information"  
from the recitation of services in Class 35 of the application.

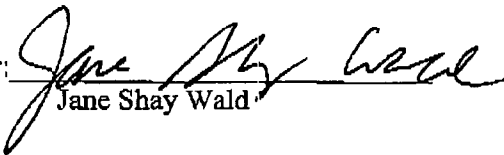
Applicant respectfully requests remand of the Appeal in order to enter an amendment deleting "Providing business marketing information." Accordingly, attached is Applicant's Amendment to delete the services above, which was filed with the Trademark Trial and Appeal Board on April 11, 2005.

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Page 2

If the request for remand is not accepted, then Applicant, instead withdraws the Appeal (which is only pending as to Class 35).

Respectfully submitted,  
IRELL & MANELLA LLP

Dated: October 21, 2005

By:   
Jane Shay Wald

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Los Angeles, California 90067  
(310) 277-1010

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Specialist

From: Jane Shay Wald

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Time: \_\_\_\_\_

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Dear Rochelle:

In accordance with our telephone conversation today, enclosed is a copy Applicant's Brief as filed with the Trademark Trial and Appeal Board on April 11, 2005.

Regards,

Jane Shay Wald.

P.S. Request for rebrand of amendment  
as filed electronically attached  
as well.

Original will be sent via: ☐ Mail ☐ Pouch ☐ Messenger ☐ Overnight Courier ☐ Will not be sent

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